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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,917	07/03/2001	Siu-Leong Ju	067339-0033	3640
20277 7590 03/17/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3621				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/763,917

**Applicant(s)**

IU ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-21, 23-30 and 62-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-21, 23-30 and 62-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

The Applicants amendment filed on December 20, 2007 is acknowledged. Claims 19-30 and 62-77 remain pending. Applicant's arguments, with respect to the rejection(s) of claim(s) 19,20,21,23-30 and 62-77 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rhoads, (US Patent No 6,363,159) in view of Saito (US Patent 6,182,218) and further in view of Chaum (US Patent 5,959,717) and further in view of Official Notice.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 19, 20, 21, 23-30 disclose "a playback unit", however the claim language states "image produced by multiple playback units, it is unclear how one playback unit can be enabled to be multiple playback units..

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19,20,21,23-30 and 62-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, (US Patent No 6,363,159) in view of Saito (US Patent 6,182,218) and further in view of Chaum (US Patent 5,959,717) and further in view of Official Notice.

As per claim 19,

Rhoads ('159) discloses a playback unit, comprising:

an input for receiving an encoded data stream bearing a video image;

(Figures 2 and 3)

Rhoads ('159) does not explicitly disclose "a decoder for decoding the encoded data stream;". Saito ('218) discloses "a decoder for decoding the encoded data stream; "(Figure 1, column 8, lines 15-18). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Rhoads ('159)'s method with Saito's teaching in order to enforce digital rights management systems.

Rhoads ('159) does not explicitly disclose " means for imparting a prescribed transformation to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer, wherein said warping changes with time during playback of the video image ". Chaum ('717) discloses "means for imparting a prescribed transformation to the video image for

warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer, wherein said warping changes with time during playback of the video image”(Column 8, lines 57-67 – column 9 lines 1-9). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Rhoads ('159)'s method with Chaum ('717) teaching in order to enforce digital rights management systems.

Official Notice is taken that the various warping techniques as describe by claims 20,21,23-30 such as spline function, quadratic function are common and well known in prior art in reference to watermarking protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a mathematical process to warp an image in order to create a predictable signature.

Claims 20, 21 and 23-30 are not patentably distinct from claim 19 and are rejected for at least the same reasons.

As per claim 22,

Rhoads ('159) discloses a playback unit in accordance with claim 19, Official Notice is taken that “warping changes upon scene change of said video image” is common and well known in prior art in reference to watermarking protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to insert warping data into digital media at point when the scene changes in order to make the warped segment inconspicuous.

Claims 62-77 are not patentably distinct from claims 19, 20, 21, 23-30 and are rejected for at least the same reasons.

***Response to Arguments***

In regards to the Applicants claim that the present rejection under 35 U.S.C § 112 is improper, the examiner states that the claimed feature of "image produced by multiple playback units," is beyond the scope of the claimed embodiment of "A playback unit"

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, the examiner states that in respons to the applicants argument that Saito does not disclose or suggest the feature of claim 19 of "a decoder for decoding the encoded data stream" that it would be obvious to one of ordinary skill in the art at the time of the invention that in order to display a graphic it would first be rendered viewable (i.e. decoded). In response to the applicants arguments that Chaum's invention is not warped by an amount readily visible by a viewer, that this is a subjective

measure, since no specific quantitative measure is provided as to the amount of warping the examiner concludes that it is possible that the warping in Chaums invention would be viewable.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Jaltee Worjloh/

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Primary Examiner, Art Unit 3621